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09/988,672	11/20/2001	Young-jin Hong	030681-330	9036

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/988,672	Applicant(s) HONG, YOUNG-JIN	
	Examiner Robert M. Pond	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended independent claims 1 and 9 and newly added claims 19 and 20. All pending claims 1-20 were examined in this non-final office action. necessitated by new grounds of rejection based on Applicant's persuasive arguments.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1, 2, 5, 6, 8, and 19 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) in view of Official Notice (regarding old and well-known in the arts, hereinafter referred to as ON1).**

Chernow teaches a telephone ordering system whereby a user can order via the telephone downloadable software. The system implements a call back feature that delivers the order software upon successful reconnection with the user and the user providing a temporary password. Chernow further teaches:

- receiving a temporary password and purchasing conditions from a user through telephone connection: (see below)
- retrieving article information meeting the purchasing conditions received in step (a), after ending the telephone connection: software product to be purchased is retrieved after ending the call (see at least Fig. 1A (g); Fig. 1B (j, k, l)).
- setting telephone connection to the user using the user's originator telephone number and confirming the user using the temporary password received in step (a): system calls the user back (see at least Fig. 1B).
- providing the article information retrieved in step (b) and arranging a transaction according to the user selection: delivers the ordered product (see at least Fig. 1B).

Chernow teaches all the above as noted under the 103(a) rejection and teaches a user a) calling an ordering service, b) submitting purchase order information and credit card number to the service (i.e. a number uniquely associated with the user and submitted for one-time use), and c) generating an acceptance key by the system that is transmitted to the user as a temporary password (i.e. one-time code) (see Fig. 1A (e, f)). Chernow, however, does not

disclose receiving a temporary password from the user. The Examiner takes the position that it is old and well-known in the arts for users of computer or telephonic technology to create their own password, personal identification number (PIN), or purchase order numbers for later use by the user and the system to verify the user's identity. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow to receive a temporary password from the user as taught by ON1. The invention of Chernow generates the temporary password (i.e. acceptance key) however the user could have as easily been queried to provide a temporary password of PIN without destroying the cited reference.

- 2. Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) and ON1 (regarding old and well-known in the arts), further in view of Official Notice (regarding old and well-known in the arts hereinafter referred to as ON2).**

Chernow and ON1 teach all the above as noted under the 103(a) rejection and teach a) the system calling the user back at the telephone number provided by the user (see at least col. 2, lines 51-54), and b) relying upon a set of predetermined telephone numbers from business customers (see at least col. 7, lines 14-43) associated with purchase order numbers, but do not specifically disclose automatically transmitting the telephone number during the telephone connection. The Examiner takes the position that automatic number identification

(ANI) is old and well-known in the arts and is used to support a variety of system interactions with callers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1 to implement ANI as taught by ON2, in order to automatically transmit the originator telephone number during a telephone connection.

- 3. Claim 4 and 7 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) and ON1 (regarding old and well-known in the arts), as applied to claims 2 and 6, further in view of Bernard (US 5,918,213).**

Chernow and ON1 teach all the above as noted under the 103(a) rejection but do not disclose text to speech. Bernard teaches a system and method of ordering products using a voice response unit to convert speech-to-text and text-to-speech (see at least Fig. 1 (100); col. 1, line 14 through col. 6, line 53). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1 to implement a voice response system for callers as taught by Bernard, in order to provide text-to-speech conversion for traditional telephone shopping.

- 4. Claims 9, 12, and 20 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) in view of ON1 (regarding old and well-known in the arts), further in view of Chen (US 5,978,775).**

Chernow teaches a telephone ordering system whereby a user can order via the telephone downloadable software. The system implements a call back feature that delivers the order software upon successful reconnection with the user and the user providing a temporary password. Chernow further teaches:

- receiving a temporary password and purchasing conditions from a user through telephone connection: (see below)
- retrieving article information meeting the purchasing conditions received in step (a), after ending the telephone connection: software product to be purchased is retrieved after ending the call (see at least Fig. 1A (g); Fig. 1B (j, k, l)).
- setting telephone connection to the user using the user's originator telephone number and confirming the user using the temporary password received in step (a): system calls the user back (see at least Fig. 1B).
- providing the article information retrieved in step (b) and arranging a transaction according to the user selection: delivers the ordered product (see at least Fig. 1B).

Chernow teaches all the above as noted under the 103(a) rejection and teaches a user a) calling an ordering service, b) submitting purchase order information and credit card number to the service (i.e. a number uniquely associated with the user and submitted for one-time use), and c) generating an acceptance key by the system that is transmitted to the user as a temporary password (i.e. one-time code) (see Fig. 1A (e, f)). Chernow, however, does not

disclose receiving a temporary password from the user. The Examiner takes the position that it is old and well-known in the arts for users of computer or telephonic technology to create their own password, personal identification number (PIN), or purchase order numbers for later use by the user and the system to verify the user's identity. The invention of Chernow generates the temporary password (i.e. acceptance key) however the user could have as easily been queried to provide a temporary password or PIN without destroying the cited reference. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow to receive a temporary password from the user as taught by ON1.

Chernow and ON1 teach all the above as noted under the 103(a) rejection but do not disclose billing a purchase charge as a telephone charge. Chen teaches a system and method that allows a purchase charge to be billed to the user's telephone bill (see at least abstract; col. Fig. 1; col. 1 through 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1, in order to provide a customer billing convenience.

5. **Claims 10, 11, and 13-18 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806), ON1 (regarding old and well-known in the arts), and Chen (US 5,978,775), as applied to claim 9, further in view of Bernard (US 5,918,213).**

Chernow, ON1, Chen teach all the above as noted under the 103(a) rejection but do not disclose text-to-speech. Bernard teaches a system and method of ordering products using a voice response unit to convert speech-to-text and text-to-speech (see at least Fig. 1 (100); col. 1, line 14 through col. 6, line 53).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow, ON1, and Chen to implement a voice response system for callers as taught by Bernard, in order to provide text-to-speech conversion for traditional telephone shopping.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Hanania, Joseph; "Securities insecurity;....." Los Angeles Times, 25 March 1997, Proquest 11317117, 5pgs; teaches investor created password necessary to do business and system call back to customer's home number.
- Maureen, Molloy; "Technology and market drivers in the remote access marketplace," Telecommunication, July 1994, v28i7pg21, Proquest #35199, 5pgs; teaches one-time passwords and dial-back system.
- US 5,345,501 (Shelton) 06 September 1994; teaches ANI, PINs, and billing.
- US 6,377,927 (Loghmani et al.) 23 April 2002; teaches telephony to internet shopping.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Yogesh Garg can be reached on 571-272-6756. The

Art Unit: 3625

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', with a stylized, cursive script.

Robert M. Pond
Primary Examiner
May 1, 2006